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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,668	02/08/2002	Heinrich Englert	P6608.0US	4591
30008	7590	02/24/2005	EXAMINER	
GUDRUN E. HUCKETT DRAUDT			GOODMAN, CHARLES	
LONSSTR. 53			ART UNIT	PAPER NUMBER
WUPPERTAL, 42289			3724	
GERMANY				

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/073,668	ENGLERT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Charles Goodman	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 November 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-8 and 16-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8 and 16-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

1. The Amendment filed on 11/23/04 and 10/13/04 have been entered.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/13/04 has been entered.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the arrangement with at least two jointing stone members (claims 6-7) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i. Claim 6 is vague and indefinite in that it is not clear what the claim encompasses. Where is this shown in the drawings? What is the scope of the claim since such may not be ascertained without a corresponding showing in the drawings? Moreover, what is the claim referring to when claim 1 sets forth that the length of the stone is greater than the cutting edge? How is it possible or defined such that two stone members would comply with the requirements of claim 1?

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4-8<sup>1</sup>, 16, 17, and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theien in view of Englert (DE 39 27 230).

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<sup>1</sup> Regarding claims 6-7, since there is no proper support for these features in the drawings and that the scope of the claims are thus unascertainable, they have been rejected herein. However, if somehow this issue is obviated, other prior art of record will be applied to these claims and the subsequent Office Action will be made FINAL. Note Osborn (US 993,398).

Theien discloses the invention substantially as claimed including, *inter alia*, at least one straight jointing stone (e.g. 40, 140) having an active jointing area that is longer than a length of the cutting edge (note Figs. 4 and 6). However, Theien lacks the step of performing at least one relative stroke. In that regard, Theien already teaches that it is known in the jointing art to perform at least one stroke in the longitudinal direction of the cutting edge. See c. 3, ll. 24-38. Moreover, Englert teaches, as per Applicant's description of this prior art in conjunction with the depiction of Figs. 1-2 of the same, an example of jointing wherein the jointing device performs at least one relative stroke between the jointing stone (13) and the inherent cutting edge (not clearly shown in the Figures) wherein the stroke length is inherently shorter than the length of the cutting edge due to the stroke length limits between the members (5, 6) and that the length of the inherent cutting edge must be as long as the length between members (5, 6) if not longer. The teachings of both Theien and Englert suggests that such a relative stroke movement allows for more even wear of the jointing stone (and therefore longer service life for the same) during the jointing operation because more of the jointing area would be used by this process. Furthermore, the stroking action provides better grinding motion between the jointing stone and the cutting edge since the grinding is not limited to one direction. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the method of Theien with the relative stroke as taught and suggested by Theien and Englert combined in order to facilitate more even wear of the jointing stone during the jointing operation.

Regarding claim 2 and similar, it appears that the modified method of Theien includes this feature. However, if it is argued otherwise, then it would have been

obvious to the ordinary artisan at the time of the instant invention to provide the modified method of Theien with the length of the jointing stone as claimed in order to facilitate optimum use of the jointing area, since due to the length relationship between the jointing stone and the cutting edge in Theien, a longer stroke length than that claimed would be unnecessary,<sup>2</sup> and since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Substantially the same reasoning applies to claim 8 in that due to the length relationship as taught by Theien, it is obvious that the stroke length would be multiple times shorter than the length of the cutting edge.

Regarding claims 4 and similar, based upon the modification above, the inherent stroke speed would be inherently multiple times smaller than the rotational speed of the rotating tool, since due to the exacting nature of jointing, a fast stroke is not advantageous for the jointing operation.

8. Claims 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theien in view of Englert (DE 39 27 230) as applied to claims 1, 2, and 4-8 above, and further in view of Mann.

It appears that the modified method of Theien would inherently include the repetition of the stroke in the opposite direction, since it is the Examiner's opinion that this is typical of the stroking step in a jointing process. However, since the modified method of Theien is silent on this step (to the extent understood of Englert), Mann

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<sup>2</sup> The jointing area of the stone already covers more than the length of the cutting edge. Therefore, a minimal stroke length is more than sufficient to provide better grinding characteristics as well as better

clearly teaches stroking of the jointing stone (22) with respect to the cutting edge wherein at least two strokes are performed via opposite directions which suggests that repetition of strokes will insure proper jointing characteristics. See c. 3, ll. 44-57. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified method of Theien with the at least two strokes as taught by Mann in order to facilitate the proper amount of grinding for the jointing process.

***Response to Arguments***

9. Applicant's arguments filed 10/13/04 have been fully considered but they are not persuasive.

Applicant's arguments are substantially the same as presented in prior remarks, and therefore, the Examiner's comments in the last Office Action remain.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (571) 272-4508. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (571) 272-4514. In lieu of mailing, it is encouraged that all formal responses be faxed to (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



**Charles Goodman  
Primary Examiner  
AU 3724**

cg   
February 22, 2005

CHARLES GOODMAN  
PRIMARY EXAMINER